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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,889	12/28/2001	Peter Jordan	72.054	8807

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EXAMINER
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LEE, SEUNG H

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/019,889

Applicant(s)

JORDAN ET AL.

Examiner

Seung H Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Prelim. Amdt./Amendment***

1. Receipt is acknowledged of the Preliminary Amendment filed on 28 December 2001.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "20" has been used to designate both a laptop and an operating hours counter. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: a reference numeral 22. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh (US 5,929,414) in view of Tuttle et al. (US 5,988,510)(hereinafter referred to as 'Tuttle').

Saitoh teaches an IC card capable of being operated with both a contact and contact-free card reader wherein the IC card comprising an memory devices such as a data memory (52), a program memory (53), and a work memory (54) wherein the memory devices are serving as an electronic storage device, the memory devices having separate inputs and outputs through the contact (55) for data transmission signals with contact IC card reader-writer and/or transceiver (56) for data transmission signals with the non-contact IC card reader-writer in which the data transmission signal was generated or performed communication process using the CPU (51) in the card, a rectifier (99) for producing the predetermined voltage to operate the IC card through the non-contact IC card read-writer wherein the rectifier is in a physical position to permitting the transmission of the power to the storage device (see Figs. 1, 6-11; col. 3, line 47- col. 6, line 45).

However, Saitoh fail to teach or fairly suggest that the IC card having written and/or graphical information on the IC card.

Tuttle teaches a smart card serving as the IC card including the written information (28) such as a card number, an expiration date, and a cardholder's name regarding the particular smart card and/or graphical information (112) such as company logo and name (see Figs. 4 and 7; col. 5, lines 37-56; col. 7, lines 34-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tuttle to the teachings of Saitoh in order to provide an alternative method of approval means wherein the user(s)/operator(s) can enter the card number and the expiration date of particular card into card reader for authorizing the various transaction such as purchasing goods/services, etc. if interfaces (i.e., contacting interface for contact mode or non-contact interface for wireless mode) are malfunctioning. Moreover, such modification would enhance and protect the appearance the card by layering the transparent film thereon, and therefore an obvious expedient.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh as modified by Tuttle as applied to claim 1 above, and further in view of Kobayashi et al. (US 6,375,082)(hereinafter referred to as 'Kobayashi').

The teachings of Saitoh/Tuttle have been discussed above.

Although, Saitoh/Tuttle teaches the dual mode smart card, they fairly particularly suggest that there is connection between the separate input and the transceiver.

However, Kobayashi teaches the smart card or a radio combination card (300) wherein the radio combination card is capable of transmitting data/information wirelessly using the parallel tuning circuit (301) having an antenna coil (301b) and/or through the wired communication using the contacting interface (401) in which the radio combination card also including a switch (309) wherein the switch is connected between

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the parallel tuning circuit and the contacting interface (see Figs. 1-3; col. 3, line 64- col. 7, line 38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of the Tuttle to the teachings of Saitoh in order to provide an improved and an enhanced system means wherein the switch is turned off when the radio combination card is engaged with card reader/writer for exchanging data/information between the reader/writer and the card while inhibiting operation of the non-contacting interface, and the switch is turned on for exchanging data/information between the reader/writer and the card while inhibiting operation of the contacting interface, and therefore an obvious expedient.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Berger et al. [US 6,168,083] and Thuringer et al. [US 6,364,207] disclose a dual mode smart card.


Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
Seung H. Lee  
Art Unit 2876  
April 7, 2003



**THIEN M. LE  
PRIMARY EXAMINER**